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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,403	10/31/2000	Jesse A. May	1700 F US	8448

26356 7590 05/08/2003  
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EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

# Office Action Summary

Application No.  
09/674,403

Applicant(s)  
May et al.

Examiner  
Bruck Kifle, Ph.D.

Art Unit  
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 7, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19, 20, 23, 24, 27-33, and 35-49 is/are pending in the application.
- 4a) Of the above, claim(s) 3, 4, 7, 8, 11, 12, 15, 16, 19, 20, 23, 24, 27-33, <sup>35-38, 41, 43, 45, 46, 48 and 49</sup> is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 9, 10, 13, 14, 39, 40, 43, 44, and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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Applicant's amendments and remarks filed 4/7/03 have been received and reviewed. Claims 1-16, 19, 20, 23, 24, 27-33 and 35-49 are pending in this application. The amendments have been entered.

Claims 1, 2, 5, 6, 9, 10, 13, 14, 39, 40, 43, 44 and 47 are under consideration.

Claims 3, 4, 7, 8, 11, 12, 15, 16, 19, 20, 23, 24, 27-33, 35-38, 41, 42, 45, 46, 48 and 49 remain withdrawn. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The finality of the previous action is withdrawn and prosecution is reopened.

***Claim Rejections - 35 USC § 112***

Claims 1, 2, 5, 6, 9, 10, 13, 14, 39, 40, 43, 44 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) It is not known in claim 2, 5, 6, 9, 10, 13, 14, 39 and 40 which atoms make-up the monocyclic heteroaromatic ring denoted by "Aryl" in claim 44. It is not known which atoms are present, how many of each is present, what size ring is intended, etc.

ii) Regarding the definition of R<sub>1</sub> throughout the claims, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

iii) In the definition of R<sup>5</sup> and R<sup>6</sup> as a ring, the claims state "R<sup>5</sup> and R<sup>6</sup> can be joined together with saturated carbon atoms to form a 5 or 6 membered ring" which is not correct. Applicants

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need an alkylene chain of 4 or 5 carbon atoms to complete the ring. A phrase, such as, "R<sup>5</sup> and R<sup>6</sup> can be joined together by a C<sub>4-5</sub> alkylene chain to form a 5 or 6 membered ring" is suggested.

Alternatively, "R<sup>5</sup> and R<sup>6</sup> can be joined together to form a pyrrolidine or piperidine ring" would make the definition clear.

iv) In claim 43, the term furan is misspelled. Appropriate correction is required.

v) In claims 44 and 47, replacing "A composition" with "A pharmaceutical composition" is suggested to indicate what kind of a composition is intended.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by May et al. (US 5,538,966). The claim reads on compounds of RN 171273-45-3 and 171273-87-3 (see Step B, col. 23, lines 57-58 and also attached CAS abstract and structures).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dean et al. (US 5,153,192). The claim reads on the compound of RN 138891-00-6 (see attached CAS abstract and structure).

Claims 5, 9, 13, 39 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizuno et al. (WO 95/18117 which is equivalent to US 5,874,429). The claim reads on the use of compounds numbers 28-79 (see Table 1). These compounds are taught to have strong serotonin-2


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blocking action (see abstract; col. 1, line 11 to col. 2, line 16; column 24, lines 19-28 and data on table 2 on col. 115).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

May 6, 2003

  
**Bruck Kifle**  
**Primary Examiner**  
**Art Unit 1624**